

Attorney's Docket: 2001US405
Serial No.: 10/002,710
Group: 1615

REMARKS

The Office Action mailed January 3, 2005, has been carefully considered together with each of the references cited therein. The remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

Claim Rejections Under 35 USC § 103

Claims 1-9 and 11-19 stand rejected under 35 USC § 103(a) as being unpatentable over LeGrow et al. (US 5,932,231) in view of JP 01268615A.

This rejection is respectfully traversed.

The Office is of the position that LeGrow discloses a cosmetic formulation comprising branched alkylsilsesquioxanes of the general formula recited in instant claim 1. The Office further contends that JP 01268615 discloses an emulsion composition for skin or hair and that such composition comprises 0.1-30 weight % polymethylsilsequioxane. The Office then concludes that one having ordinary skill in the art "would have been motivated to prepare the formulation of LeGrow as an emulsion according to the teaching of JP 012686615."

Applicants respectfully contend that the Office has not carried its burden of providing a *prima facie* case of obviousness. A *prima facie* case of obviousness under § 103 requires the prior art to provide some suggestion or motivation to one of ordinary skill in the art to modify the references and thus arrive at the claimed invention. Here, there exists no motivation supplied by the references for one with ordinary skill in the art to entertain preparing a composition having trimethylsilylalkylsilsesquioxane in emulsion form. Furthermore, the "teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and

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not based on applicant's disclosure." MPEP § 2142; citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991).

JP 012686615 discloses an emulsion comprising polymethylsilsesquioxane. The polymethylsilsesquioxane material is not a fluid, but, rather, an insoluble high molecular weight gel with a particle size ranging from 0.1 to 10 microns and a mesh fractionation ranging from +/- 30% of average partial size. The polymethylsilsesquioxane disclosed in JP 012686615 is insoluble in water, organics and silicones.

Applicants' invention is directed to a leave-on composition having at least one trimethylsilylalkylsilsesquioxane. The trimethylsilylalkylsilsesquioxane is a fluid with a much lower molecular weight than polymethylsilsesquioxane gel. Moreover, trimethylsilylalkylsilsesquioxane is compatible with alkylsiloxanes and some organics.

One with ordinary skill in the art having a knowledge of LeGrow and JP 012686615 would derive no motivation from either reference to alter the LeGrow reference to form an emulsion. JP 012686615 is directed to an emulsion having a completely different siloxane compound. The polymethylsilsesquioxane gel particles of JP 012686615 are insoluble and of high molecular weight, whereas the trimethylsilylalkylsilsesquioxane of Applicants' leave-on composition is a fluid with a low molecular weight and is soluble in both alkylsilsesquioxane and many organics. The fundamentally distinct chemical and functional characteristics of these compounds would preclude one from ordinary skill from deriving any motivation from JP 012686615 to conclude that trimethylsilylalkylsilsesquioxane could be used in a leave-on composition in emulsion form. Simply put, the compounds advanced by Applicants' present invention and JP 012686615 have such entirely different chemical structures and disparate properties that one with ordinary skill in the art would not entertain the prospect of using the

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trimethylsilylalkylsilsesquioxane in an emulsion without the benefit of Applicants' disclosure.

Courteously stated, the Office's *prima facie* case is also deficient because there exists within JP 012686615 and LeGrow no reasonable expectation of success. There is nothing in either reference that provides the ordinary artisan with any evidence that a soluble, low molecular weight, fluid siloxane could be used in an emulsion rather than the insoluble, high molecular weight gel particles advanced by JP 012686615. It is beyond contention that the reasonable expectation of success must be derived from the references itself and not an applicant's disclosure. Indeed, the Office is taking two materials that are physically different forms of matter, namely, solid versus a liquid, and imparting the ordinary artisan with the knowledge that one form of matter could be substituted for another in an emulsion. With all respect, this can not be done absent the use of permissible hindsight gained by a knowledge of Applicants' invention.

Assuming one with ordinary skill in the art would consider JP 012686615 as a relevant teaching, what the Office has established, in Applicants' courteous opinion, is an obvious to try rational. It is well settled, however, that one can not base a determination of obviousness on what the ordinarily skilled artisan might try or find obvious to try. Permitting a patentability determination to be based on an obvious to try rational would be contrary to the statute. In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

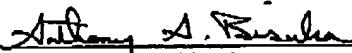
For at least the reasons advanced above, Applicants contend that the claimed invention is not made obvious by any combination of LeGrow and JP 012686615. In consequence, Applicants respectfully solicit reconsideration and withdrawal of the § 103 rejection.

In view of the forgoing remarks, the Application is believed to be in condition for allowance, and reconsideration of it is requested. If the

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Examiner disagrees, she is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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